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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/987,978

11/16/2001

Yujiro Kajihara

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7905

20457

7590

05/14/2009

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EXAMINER

CLARK, JASMINE JHIHAN B

ART UNIT

PAPER NUMBER

2815

MAIL DATE

DELIVERY MODE

05/14/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/987,978	<b>Applicant(s)</b> KAJIHARA ET AL.	
	<b>Examiner</b> Jasmine J. Clark	<b>Art Unit</b> 2815	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/09/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

***Reissue Applications***

1. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

A new Oath/Declaration is needed. The error being corrected in the Oath of 11/16/01 is no longer applicable to this reissue. The error refers to newly added claims 15-36 directed to a method of manufacturing, whereas claims 15-26 now pending are directed to a device. It appears that applicant has used the Oath presented in reissue 09/328910.

The supplemental Oath of 11/01/04 does not recite an error correctable by reissue. The Oath refers to a “method of manufacturing” which is not being claimed and other portions are unclear as to the error being corrected.

The Oath/Declaration must properly identify at least one (35 U.S.C. 251) error being relied upon a basis for the reissue and that it is indeed an appropriate error for reissue (37 CFR 1.175(a)(1)). For example, “failure to include the following claims in the original patent...” is not an acceptable statement of an error.

An error in the claims must be identified by reference(s) to the specific claim(s) and the specific claim language wherein lies the error. A statement of “...failure to include a claim directed to ...” and then presenting newly added claims, would not be considered a sufficient “error” statement since applicant has not pointed out what the other claims lacked that the newly added claims have, or vice versa. Such a statement would not be no better than saying in the reissue Oath/Declaration that “this application is being filed to correct errors in the patent which may be noted from the change made

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by adding new claim 10, for example. In both cases, the error has not been identified.

Claims 15-26 are rejected as being based upon a defective reissue

Oath/Declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the Oath/Declaration is set forth in the discussion above in this Office action.

2. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

1. Clarification is needed as to the claiming of benefit to copending reissue 09/328910. This reissue should be claimed as a division of 09/328910, otherwise the two-year bar against the reissue application broadening invention applies. See form paragraph 2.15. The claim for benefit under 35 USC 120 must be included in the first sentence of the specification.

2. Claims 15-26 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. Reissue 09/989242 was filed 11/21/01 more than two years from the patented date of US Patent 5,637,913. A claim is broader in scope than the original claims if it contains within its scope any

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conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

During the prosecution of the patent under reissue, the claims 25 and 27 were amended to overcome art such that bonding wires “is positioned under a substantially central portion of said semiconductor chip, wherein”, by adhesive, and “wherein said semiconductor chip is fixed to a part of each of said suspension leads by adhesive which is located under a peripheral portion of said semiconductor chip,” and argued.

Claim 49 had “positioned under a substantially central portion” and “by adhesive” added and argued, and “and wherein said semiconductor chip is fixed to a part of each of said suspension leads by adhesive which is located under a peripheral portion of said semiconductor chip” added and argued.

Claims 25 and 29 had “an adhesive region of said chip mounting portion and said semiconductor chip and an adhesive region of each of said suspension leads and said semiconductor chip are separated from each other”.

Claims 25, 29, 43, 53 and 54 had added: “wherein said suspension leads and said chip mounting portion of said lead frame or continuously formed in an area of said semiconductor chip” and argued.

The reissue claims rejected under recapture remove part or all of one or more of the amendment made during the prosecutions listed above. According to MPEP section 1412.02, broadening a claim limitation amended during prosecution to overcome art is recapture, and should be rejected accordingly. Therefore, the removal

of these limitations constitutes recapture.

***Information Disclosure Statement***

3. The IDS filed 10/09/2008 has been considered.

***Telephone Inquiry Contacts***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasmine J. Clark whose telephone number is (571) 272-1726. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPRE, Jose Dees can be reached on (571) 272-1569. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner, Art Unit 2815